

REMARKS

This Amendment is submitted in response to the outstanding Office Action dated March 26, 2004 wherein the Examiner rejected Claims 1-24. Reconsideration of the rejections in view of the following remarks is respectfully requested.

The Rejection under 35 USC Section 103

The Examiner rejected claims 1-19 under 35 USC Section 103 as being unpatentable over Admitted prior Art (APA) in view of Gibbs et al (US 6,292,187) and further in view of Paramvir Bahl (Software-only Compression, Rendering, and Playback of Digital Video). Applicants respectfully traverse this rejection on the grounds that Applicants' attorney does not see where in Paramvir it shows a reverse DAPD application program interface as defined in Applicants specification and claims.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP Section 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis is to deny patentability to a claimed invention is always upon the Patent Office. MPEP Section 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established

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does the burden shift to the applicant to produce evidence of non-obviousness. MPEP Section 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP Section 2142.

The Examiner rejected the claims stating that the Admitted Prior Art teaches a digital audio play back device, a connected processing system, executing, the external interface, a user interface application program, a program for controlling the connected user interface, a memory, storing, a [reverse] DAPD application programming interface but that the admitted prior art does not teach a DAPI API capable of external interface causing a

processor to access and control a user interface and display on a monitor screen associated with said connected processing system. The Examiner stated that Gibbs teaches DAPI API capable of external interface causing a processor to access and control a user interface and displayed on a monitor. The Examiner stated that APA and Gibbs do not teach a reverse API, however that Paramvir teaches a reverse API because it states that the API is able to support operation such as random access [fast] forward and fast reverse (page 31, lines 33-37).

Applicants respectfully submit that this combination is improper because first the Examiner must show where there is a suggestion in the prior art to combine the references and where in the prior art it shows a reasonable expectation of success. In addition, even if the references were combined they do not teach or suggest every element of the claimed invention. The Examiner did not find each element in a single reference but rather used three references (APA, Gibbs and Paramvir) to combine and create Applicants invention. Applicants wish to note that the Examiner only sent 23 out of the 36 pages of the Paramvir reference. Applicants' attorney tried to find this reference in its entirety on the Internet and believes she found it but the page numbers differed from the Examiner's page numbers. The Examiner used Paramvir to create the element of a reverse API. The Examiner stated that Paramvir teaches reverse API because it states that "the API is able to support operation such as random access, [fast]

forward and fast reverse, page 31, line 33-37." Applicants believe the following section includes the paragraph the Examiner was quoting:

RELATED WORK

While considerable effort has been devoted to optimizing video decoders, little has been done for video encoders. Encoding is generally computationally more complex and time-consuming than decoding. As a result, obtaining real-time performance from encoders has not been feasible. Another rationalization for interest in decoders has been that many applications require video playback and only a few are based on video encoding. As a result, "code once, play many times" has been the dominant philosophy. In most papers, researchers have focused on techniques for optimizing the various codecs; very little has been published on providing a uniform architecture and an intuitive API for the video codecs.

In this section, we present results from other papers published on software video codecs. Of the three international standards, MPEG-1 has attracted the most attention, and our presentation is biased slightly toward this standard. We concentrate on work that implements at least one of the three recognized international standards...

Bheda and Srinivasan describe the implementation of an MPEG-1 decoder that is portable across platforms because the software is written entirely in a high-level language. [22] The paper describes the various optimizations done to improve the decoder's speed and provides performance numbers in terms of number of frames displayed per second. The authors compare the speed of their decoder on various platforms, including Digital's first Alpha-based PC running Microsoft's Windows NT system. They conclude that their decoder performed best on the Alpha system. It was able to decompress, dither, and display a 320-pixel by 240-line video sequence at a rate of 12.5 frames per second. A very brief description of the API supported by the decoder is also provided. The API is able to support operations such as random access, fast forward, and fast reverse. Optional skipping of B-frames is possible for rate control. The authors conclude that the size of the cache and the performance of the display subsystem are critical for real-time performance. (emphasis added)

Applicants respectfully submit that this section teaches that the API is able to support certain operations, but it does not teach or suggest a reverse DAPD API which is capable of causing said processor to access and control a user interface associated with said user interface application program, let alone a memory which stores the reverse DAPD being coupled to the external interface.

Applicants take this opportunity to describe the cited portions of the references relied upon by the Examiner. Gibbs describes an "intelligent device" that receives a broadcast stream such as from a cable provider or satellite provider col. 5 lines 31 -36. The broadcast stream includes software application programs, which construct User Interfaces. The broadcast applications are downloaded via the broadcast stream and reside in the "intelligent device" such as a digital television. The system described in Gibbs provides for modification of the broadcast application user interface without altering the broadcast application. (Col. 1, lines 15-54 and col. 2, lines 15-45). The Examiner correctly pointed out that neither the admitted prior art nor Gibbs shows a reverse API. Applicants respectfully submit that not only do they not show a reverse API they do not show a reverse API stored in a memory coupled to an external interface, where the reverse API causes the processor to access and control a user interface associated with the user interface application program that

accesses and controls the digital audio playback device, as recited in Applicants' claims.

The Paramvir reference merely states that "[t]he API is able to support operations such as random access, fast forward, and fast reverse." Applicants do not see where it states that the API is a reverse digital audio playback device application program interface. If Paramvir were combined with Gibbs and the admitted prior art it would only teach an application program interface which can support operations such as random access, fast forward and fast reverse. There would be no teaching alone or in combination that the API is a reverse API that is used to control a user interface associated with a user interface application program that accesses and controls a digital audio playback device. Rather Paramvir merely teaches an API in a video decoding environment that can support fast forward, fast reverse and random access. In Applicants invention, a reverse API is, for example, one that requests that a user interface application program display some information on a screen such as the logo of the DAPD manufacturer.

In addition, the user interface application program uses the reverse DAPD APIs to obtain the DAPD-specific data and uses the accompanying executable code to display, for example DAPD specific information. (Page 16, lines 1-17) The API described in Paramvir does not meet this definition of a reverse API. Accordingly, Applicants respectfully submit that the combined references do not teach or suggest Applicants' invention. Entry of this Amendment

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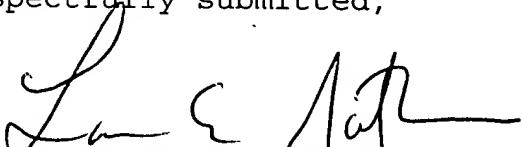
reconsideration of the rejections and allowance of all the claims is respectfully requested.

The rejection of Claims 20-24

The Examiner rejected claims 20-24 under 35 USC Section 103 as being unpatentable over APA in view of Gibbs, in view of Paramvir Bahl, and further in view of Fanshier et al (US Patent No. 5,751,962). The Examiner stated that the Fanshier reference teaches the element of instructions stored in a removable readable storage medium which was not taught by the combination of APA, in view of Gibbs in view of Paramvir. Applicants respectfully traverse this rejection for the reasons stated above with respect to Paramvir and because Fanshier does not make up for the deficiency sited above with respect to Paramvir. Accordingly, Applicants respectfully submit that these claims are allowable over the references of record.

Entry of this Amendment reconsideration of the rejections and allowance of all the claims is respectfully requested.

Respectfully submitted,

By 
Laurie E. Gathman, Reg. 37,520

Attorney
(914) 333-9605

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On April 30, 2004
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